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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,842	02/11/2002	Arturo A. Rodriguez	A-7496	6628

5642 7590 12/24/2003

SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
5030 SUGARLOAF PARKWAY
LAWRENCEVILLE, GA 30044

EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,842

Applicant(s)

RODRIGUEZ ET AL.

Examiner

KIEU-OANH T BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 79-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 79-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/14/2003 was filed after the mailing date of the office action on 06/25/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

1. 2. Applicant's arguments with respect to claims 79-104 (new) have been considered but are moot in view of the new ground(s) of rejection.

Remark

3. Claims 1-78 were canceled in the amendment no 5 (dated 9/29/03).

Claim Rejections - 35 USC 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

5. Claims 79-104 are rejected under 35 U.S.C. 102(e) as being anticipated by Ozer et al. (U.S. Patent Pub No. US2003/0101454 A1/ or "Ozer" hereinafter).

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Regarding claim 79, this limitation is met as Ozer discloses a method implemented by a television set top box or set top terminal (STT) comprising the steps of outputting by the STT a list of advertisement categories, and under a user input at the STT for identifying or selecting a category of advertisements at the STT, the corresponding advertisements are downloading to the STT responsive to the user input (see Fig. 8 and page 2/section 0019 for an overview of a receiver device, such as a set top box; page 14/sections 0141, 0142, 0143 for the advertisement data is stored in category order, and based on the user input for advertisement contents, the advertisement contents corresponding to an interested category is displayed to the user, see more at page 18/section 0178 and page 19/section 0182).

As for claims 80 and 81, these limitations are met as Ozer discloses further comprising outputting the advertisement to a television during an interruption in a television program, or in other words, between portions of broadcast programming and at predetermined time periods (pages 16-17, sections 0161 & 0162 as the advertisements can be scheduled at any time at various different locations).

As for claim 82, this limitation is met as Ozer discloses that user interaction for advertisement content is recorded in a log as means for identifying that at least a portion of the advertisement was viewed by the user (Fig. 9, step 334 through step 342, and page 19, section 0181 & 0182).

As for claim 83, this limitation is met as Ozer further discloses comprising outputting the advertisement to a television only during interruption of television programs having a predetermined type, i.e., based on advertisement campaigns for predetermined type of targeting advertisements, the reservation module can reserve and schedule the advertisements at particular

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times either into hourly, daily, weekly and so on (page 12/section 0118) as well as between portions of programming (pages 16-17, section 0161).

As for claim 84, this limitation is met as Ozer further discloses that various attributes associated with groups of the advertisement contents as the subcategory of advertisements such as the range of times the advertisement can be displayed (page 13, section 0127).

As for claim 85, this limitation is met as Ozer further discloses that advertisements has defined duration display times, and they are stored within the receiver 20 or the set top terminal (page 17/section 0162 & 0176, and being removed after the predefined period (as illustrated in Fig. 9, step 336).

As for claims 86 and 87, these limitations are met as Ozer further discloses that based on advertisement weights specified by the user, i.e., the frequency of displaying advertisements or the number of advertisement display (page 10/section 0095), the advertisements which are viewed at least a predetermined number of times can be excluded or removed from the advertisement list (Fig. 9, step 336, and col. 19, sections 0180 & 0181).

As for claims 88-96, these same limitations are rejected for the reasons given in the scope of claims 79-87 as disclosed in details above.

As for claims 97-100, these claims for the method concerned that the user can determine or control the output of the advertisement based on values or compared to a predetermined number of times, or the frequency of output (Ozer calls it weights), by the STT, for instance, the output for the advertisement is out if the determination is checked that the advertisement is out less than a predetermined number of times as well as the prompting for the user to select or provide the user input to confirm the user's intention (see Fig. 9, and claims 86-87 as the user

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controls this setting for the display of the advertisement contents based on weights, or the predetermined number of times for displaying).

Regarding claim 101, Ozer further discloses a television set top terminal (Fig. 8, and page 15, section 0145 & 0146, Ozer mistakenly provides incorrect reference labeled numbers; however, this is for an illustration of components of receiver 20, which can be a TV set top terminal, as described in page 2/section 0019) comprising a memory configured store program code (Fig. 9 for system memory 234, and page 15/section 0145), and a processor that is programmed by the program code (Fig. 8, for processing unit 230) to enable the STT to download responsive to user input an advertisement corresponding to a category of advertisements as described earlier (page 15, section 0146, and claim 79).

As for claim 102, this limitation is met and is rejected as described in claim 80.

As for claims 103 and 104, these limitations are combined limitations of claims 101 and 79-80 and are rejected for the reasons given as stated earlier.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bentolila et al. (US PUB 2003/0101451 A1) and Slaney et al. (US PUB 2002/0062481 A1) disclose electronic program guides with advertisements and method for selecting advertisements.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


ANDREW FAILE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Krista Bui
Art Unit 2611
December 12, 2003